

REMARKS

Applicant gratefully acknowledges the telephonic interview with the Examiner conducted on April 3, 2008. Applicant has attempted to address the issues raised by the Examiner in the interview with this response.

Applicant has considered and studied the Office Action dated December 11, 2007. Claims 1-5, 7-14, and 16-22 are pending. Claims 1, 3-5, 7, 8, 10, 12-14, 16, 17, and 20-22 have been amended and claims 6 and 15 have been canceled without prejudice. Claims 1, 10, and 19 are independent claims.

It is submitted that the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to Specification

Amendments have been made to the specification at page 1 in order to indicate the priority claim to the foreign application. Accordingly, no new matter has been added.

Amendments to the Claims

Claims 1, 3-5, 7, 8, 10, 12-14, 16, 17, and 20-22 have been amended to more clearly disclose the invention. It is respectfully submitted that the amendments have support in the application as originally filed.

§ 103 Rejections

Claims 1-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerszberg et al. ("Gerszberg '881" U.S. Pat. No. 6,359,881) in view of Gerszberg et al. ("Gerszberg '621" U.S. Pat. Appln. No. 2001/0040621). Applicant respectfully traverses the rejection.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijken, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. ‘A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.’ If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned.” (citations omitted.)

It is well-settled law that to support a finding of obviousness, a reference must provide some motivation, working without the benefit of the applicant’s specification, to make the necessary changes in the device disclosed in the reference. The mere fact that a worker in the art could modify the reference to meet the terms of the claims is not, by itself, sufficient. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

It is further respectfully noted that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02 (emphasis in original).

With this paper, claims 6 and 15 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claims 6 and 15 and it is respectfully requested that the rejection be withdrawn.

First of all, it is respectfully noted that Gerszberg ‘621 has been cited by the Examiner to cure the deficiencies of Gerszberg ‘881, which teaches “the transmission of information to the terminal at any point in time” (page 3 of the Office action). Specifically, it is noted that the Examiner cites Gerszberg ‘621 for teaching “information, advertisements, is transmitted to a videophone when it is determined that the videophone is not in use (p. 5, para. 0042) and therefore the videophone is in an on-hook condition.”

However, as was respectfully submitted in the last response dated August 30, 2007 and in the interview on April 3, 2008, the disclosure of Gerszberg '881 and Gerszberg '621 are contradictory with respect to the display of the advertisement. It is respectfully noted that the Examiner, in the "Response to Arguments" as paragraph 28 of the present Office Action, fails to address the specific remarks that were presented in the previous response. It was respectfully requested in the interview that the Examiner respond to the following remarks, which were presented in the previous response:

Furthermore, it is respectfully submitted that even if the videophones disclosed in Gerszberg '881 and Gerszberg '621 may be similar in a way as asserted by the Examiner, there is at least one significant difference between the videophones of Gerszberg '881 and Gerszberg '621, which distinguishes them clearly, and thus, making it impossible to combine these two references to arrive at the presently claimed invention.

As asserted by the Examiner, the videophone of Gerszberg '881 displays the stored information on the display of the terminal when the terminal enters an "on-hook" status. However, it is respectfully noted that the Examiner is silent about the display in the videophone of Gerszberg '621, which displays advertisements on a videophone when the videophone is in use, and therefore, the videophone is in an "off-hook" status when advertisements are displayed, contrary to the videophone of Gerszberg '881, which displays the information in an "on-hook" status. Specifically, Gerszberg '621 discloses systems and methods for displaying video advertisements on a videophone when the videophone is linked to a non-video enabled telephone, i.e., when the videophone is in use for communicating with other phone, but the videophone's display is not in use and the videophone user is near the videophone during a telephone call (p. 1, para. 0009 and p. 4, para. 0039).

Therefore, Gerszberg '621, which discloses a videophone downloading (transmitting) advertisements when the videophone is not being used, i.e., in an "on-hook" status, but displaying advertisements on the videophone when the videophone is in use, i.e., in an "off-hook" status, fails to cure the deficiency of Gerszberg '881, which discloses transmitting information to a videophone at any point, i.e., in both "on-hook"

and “off-hook” status, and displaying advertisement on the videophone whenever the videophone is not in active use, i.e. in an “on-hook” status. Accordingly, in view of the contradicting disclosure of Gerszberg ‘881 and Gerszberg ‘621, they fail to be combinable to arrive at the presently claimed invention, wherein the stored information is transmitted to each of a plurality of terminals during an “on-hook” status and displayed on a display unit of each of the plurality of terminals that is in the “on-hook” status.

In the interview on April 3, 2008, it was respectfully noted that the Examiner asserts at paragraph 30 of the Office action and that col. 11, ll. 65-66 of Gerszberg ‘881 discloses “[a]dvertising can be displayed on the video phone, whenever the videophone is not in active use.” It was respectfully noted in the interview that the videophone of Gerszberg ‘881 displays the advertisement on the display when the videophone enters an “on-hook” status.

In contrast, it was respectfully noted in the interview that the videophone of Gerszberg ‘621 displays advertisements when the videophone is in use or during “off-hook” status. Specifically, it was noted in the interview that paragraph 0009 of Gerszberg ‘621 discloses “displaying video advertisements on a videophone when the videophone is linked to a **non-video-enabled telephone**” and “[s]ince some or all of the videophone’s display might not be otherwise used, and the videophone user may be near the videophone during a telephone call, the user would be a captive audience to these advertisements.”

Therefore, it was respectfully submitted in the interview that even if Gerszberg ‘621 teaches transmitting advertisements to a videophone when the videophone is in an “on-hook” condition, one of ordinary skill in the art would not look to Gerszberg ‘621 to modify the Gerszberg ‘881 invention without the benefit of impermissible hindsight based upon the benefit of the applicant’s specification since the videophone of Gerszberg ‘621 is in an “off-hook” status when advertisements are displayed, while the videophone of Gerszberg ‘881 displays the advertisements in an “on-hook” status. Accordingly, it was further respectfully submitted in the interview that Gerszberg ‘621, which discloses contradictory features for the similar videophone as Gerszberg ‘881,

teaches away from the asserted combination of references and, therefore, the combination of Gerszberg '621 and Gerszberg '881 is improper and cannot be relied upon to disclose or suggest the information stored in the memory unit is displayed on a display unit of each of the plurality of terminals during the on-hook status, as recited in amended independent claims 1 and 10, and displaying the information temporarily stored at each of the plurality of terminals on a display unit of each of the plurality of terminals during an on-hook status, as recited in amended independent claim 19.

The Examiner submitted in the interview of April 3, 2008 that the combination of Gerszberg '881 and Gerszberg '621 is proper because Gerszberg '621 does not specifically teach that the "advertisement" cannot be displayed in the "on-hook" status. Applicant respectfully disagrees with the Examiner's position and respectfully submits that the Examiner's asserted combination of references relies on impermissible hindsight of the present invention. Moreover, even if Gerszberg '621 does not explicitly teach that the "advertisement" cannot be displayed in the "on-hook" status, the following disclosure of Gerszberg '621 inherently teaches away from displaying the "advertisement" in the "on-hook" status: "[w]here a videophone is linked with a non-video enabled device, some or all of the display of the videophone may be blank, in a screen-saver mode, or otherwise not put to any good use. [t]o take advantage of the unused videophone display 141, advertisements may be displayed on it.
[a]dvertisements may [[be]] also be displayed when a videophone user is put on hold, communicating with a non-video enabled user." (emphasis added, paragraph 0038 in Gerszberg '621).

Notwithstanding that the combination of Gerszberg '621 and Gerszberg '881 is improper, it was respectfully submitted in the interview that the asserted combination of Gerszberg '881 and Gerszberg '621 still fails to teach the recited determining a call status of each of the plurality of terminals recited in independent claims 1, 10 and 19. It was respectfully noted in the interview that the claims recite a specific way in which the determining is performed, specifically based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system in independent claim 1 and based on call status information included in

call setup information transmitted from each of the plurality of terminals in independent claims 10 and 19.

It was respectfully noted in the interview that the Examiner provides no indication of any teaching in either Gerszberg '881 or Gerszberg '621 the call status is determined based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system or based on call status information included in call setup information transmitted from each of the plurality of terminals. It was respectfully submitted in the interview that the cited portions of Gerszberg '881 merely teach the "[a]dvertising can be displayed ... whenever the videophone is not in active use" and the cited portions of Gerszberg '621 merely teach that "advertisements may be downloaded ... when the videophone is not being used."

It was respectfully submitted in the interview that the Examiner must be interpreting Gerszberg '881 and Gerszberg '621 as inherently teaching determining a call status of each of the plurality of terminals. It was further respectfully submitted in the interview that even if Gerszberg '881 and Gerszberg '621 arguably do teach determining a call status of each of the plurality of terminals, the cited portions cannot be interpreted to inherently teach that the determining is based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system or based on call status information included in call setup information transmitted from each of the plurality of terminals. Therefore, it was respectfully submitted in the interview that the improper combination of Gerszberg '881 and Gerszberg '621 cannot be asserted as teaching determining a call status of each of the plurality of terminals that is based on call status information included in the call setup information exchanged between each of the plurality of terminals and the gateway system, as recited in independent claim 1, or based on call status information included in call setup information transmitted from each of the plurality of terminals, as recited in independent claims 10 and 19.

The Examiner apparently argued during the interview on April 3, 2008 that neither Gerszberg '881 nor Gerszberg '621 teaches any specific way in which the call status of a terminal is determined.

Notwithstanding that the combination of Gerszberg '621 and Gerszberg '881 is improper, it was respectfully noted in the interview that the Examiner asserts, at paragraph 7 of the Office action with respect to claim 3, that col. 8, ll. 44-52 of Gerszberg '881 teaches "the system wherein each of the plurality of terminals includes a memory means for storing information transmitted from the information server," that col. 11, ll. 65-66 of Gerszberg '881 teaches "a control means for controlling the storing of the transmitted information in the memory means such that the information stored in the memory means is displayed when the on-hook status is detected" and that col. 9, ll. 17-27 of Gerszberg '881 teaches "voice communication-related information is displayed when an off-hook status is detected." It was further respectfully noted in the interview that the Examiner, at paragraph 26 of the Office Action with regard to claim 22, asserts that col. 9, ll. 17-27 of Gerszberg '881 also teaches "ceasing the display of the stored information."

With regard to col. 8, ll. 44-52 of Gerszberg '881, it was respectfully noted in the interview that the disclosure is "store information representing users' preferences and/or the received uni-cast or multicast information in memory ... for **later play**" and "for example, **video clips** or **movies** may be multicast to all customers." (emphasis added). Specifically, it was respectfully noted in the interview that col. 8, ll. 44-52 of Gerszberg '881 discloses "multicast broadcast services." Therefore, it was respectfully submitted in the interview that col. 8, ll. 44-52 of Gerszberg '881 discloses multicast broadcast services for multicasting video clips or movies, but fails to disclose or suggest that the information stored in the memory unit is at least one of an advertisement, a guide and a bulletin, as recited in amended independent claims 1, 10, and 19.

The Examiner requested in the interview on April 3, 2008 that the Applicant provide further clarification of advertisement as recited in claims, 1, 10, and 19. Applicant respectfully submits that the advertisement recited in claims 1, 10, and 19 is patentably different from the "multicast broadcast services" disclosed in Gerszberg '881.

Applicant respectfully submits that Gerszberg '881 also supports that the advertisement and the multicast broadcast services are not the same because as asserted by the Examiner, col. 11, ll. 58-66 of Gerszberg '881 discloses specifically "advertising" while col. 8, ll. 44-52 of Gerszberg '881 discloses specifically "multicast broadcast services" which includes "all country music broadcasts" and "financial information." However, the latter cited portion of Gerszberg '881 does not disclose or suggest that the "multicast broadcast services" includes the "advertising." It was respectfully noted in the interview that the information as recited in claim 3 is the same information as recited in independent claim 1 which is at least one of an advertisement, a guide and a bulletin. Therefore, it is respectfully submitted that the cited combination of references fails to disclose or suggest each of the plurality of terminals includes a memory means for temporarily storing the information transmitted from the information server during the on-hook status, as recited in claim 3.

With regard to col. 11, ll. 65-66 of Gerszberg '881, it was respectfully noted in the interview that the disclosure is "[a]dvertising can be displayed on the videophone, whenever the videophone is not in active use." It was respectfully submitted in the interview that "advertising" disclosed at col. 11, ll. 65-66 of Gerszberg '881 is different from the "multicast information" disclosed at col. 8, ll. 44-52 of Gerszberg '881. Furthermore, it was respectfully submitted in the interview that it is well-known in the art that multicast information, such as video clips or movies, is multicast to the customer and displayed on the display in response to the customer's demand because displaying the video clips or movies whenever the videophone is in the "on-hook" status would not make sense unless the customer is viewing the display of the videophone.

Therefore, it was respectfully submitted in the interview that the asserted "multicast information, such as video clips or movies" that is disclosed as "stored" at col. 8, ll. 44-52 of Gerszberg '881 and the asserted "information" or "advertising" that is disclosed as "displayed" at col. 11, ll. 65-66 of Gerszberg '881 are not the same. It was further respectfully submitted in the interview that the disclosure at col. 11, ll. 65-66 of Gerszberg '881 is not sufficient to disclose or suggest the information stored in the

memory means is displayed on the display unit when the on-hook status is detected, as recited in amended claim 3.

With regard to col. 9, ll. 17-27 of Gerszberg '881 in connection with the rejection of claim 22, it is respectfully noted that the disclosure is “[w]hen the videophone 130 is used as a videophone, the display 141 may include one or more video window(s) 160” and “[t]he display may also include a dialed-telephone-number window 161.” It is further respectfully noted that the Examiner has interpreted, at paragraph 26 of the Office action, this disclosure as teaching “ceasing the display of the stored information and displaying voice communication-related information on any of the plurality of terminals that assumes an off-hook status.”

As previously respectfully submitted, Gerszberg '621 discloses displaying the advertisement in the “off-hook” status. Therefore, it is again respectfully submitted that the disclosure of Gerszberg '881 and Gerszberg '621 are contradictory with respect to displaying during the “off-hook” status because Gerszberg '881 discloses displaying “voice communication-related information” during the “off-hook” status while Gerszberg '621 discloses displaying the “advertisement” during the “off-hook” status. Therefore, it is respectfully submitted that Gerszberg '621, which discloses displaying “advertisement” in the “off-hook” status, and Gerszberg '881, which discloses displaying “voice communication-related information” during the “off-hook” status, are not combinable to arrive at ceasing displaying the stored information and displaying voice communication-related information on at least one of the plurality of terminals that assumes an off-hook status, as recited in amended claim 22.

As previously respectfully noted, “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Therefore, it is again respectfully submitted that the combination of Gerszberg '881 and Gerszberg '621 is improper.

For the reasons above, it is respectfully asserted that independent claims 1, 10 and 19 are allowable over the cited combination of references. It is further respectfully asserted that claims 3 and 22 also are allowable over the cited combination of references both by virtue of the limitations recited therein as well as by virtue of their

dependence from an allowable independent claim. Moreover, it is respectfully asserted that claims 2, 4, 5, 7-9, 11-14, 16-18, 20 and 21 also are allowable over the cited combination of references by virtue of their dependence from an allowable independent claim.

CONCLUSION

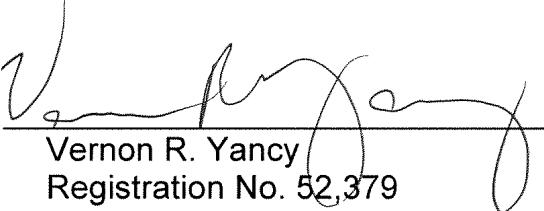
In view of the above remarks, Applicant submits that claims 1-5, 7-14, and 16-22 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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